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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/526,031	03/15/2000	Jonathan J. Hull	74451.P114	9293

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EXAMINER

SMITH, PETER J

ART UNIT	PAPER NUMBER
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2176

DATE MAILED: 07/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/526,031

Applicant(s)

HULL ET AL.

Examiner

Peter J Smith

Art Unit

2176

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 08 July 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☐ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.


Claim(s) objected to: _____.

Claim(s) rejected: _____.

Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
10. ☐ Other: _____

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JOSEPH FEILD
SUPERVISORY PATENT EXAMINER

Continuation of 5. does NOT place the application in condition for allowance because: Regarding Applicant's argument on pages 10-12 that Covington, Gormish and Russell do not teach the limitations of independent claims 1, 13, 25, and 37, the Examiner believes the combination of the references by one of ordinary skill in the art at the time of the invention renders the claimed invention obvious. Contrary to Applicant's opinion expressed in pages 10-12, the Examiner believes electronic and paper documents are intimately related and knowledge of the relationship between the two was known by those of ordinary skill in the art at the time of the invention. Covington teaches very clearly creating and providing multimedia annotations to enhance an electronic document. The electronic document of Covington certainly could have been printed out physically, resulting in a loss of the multimedia annotation. Gormish and Russell teach the link between paper documents and electronic data which would have enabled one of ordinary skill in that art at the time of the invention to have enhanced Covington to retain the link to the multimedia annotation even after the document has been physically printed onto paper. This obvious combination reads upon the independent claimed invention. Regarding Applicant's arguments on pages 12-13 that Covington, Gormish, and Russell do not teach the limitations of dependent claims 8, 20, and 32, the Examiner believes the result of implementing these claims is an electronic document version of the paper document which has multimedia annotations. This actually is exactly what the invention of Covington is. Covington discloses an electronic document annotated with electronic multimedia files. Covington simply does not indicate that the origin of the electronic document may be from a scanned paper document. The Examiner merely used Russell to teach converting a paper representation of the document into an electronic version of the document. Regarding Applicant's arguments on page 14 that Covington, Gormish, Russell and Halliday do not teach the limitations of dependent claims 11, 23, and 35, the Examiner believes Halliday does teach the claimed limitation in combination with Covington, Gormish, and Russell. Halliday teaches transmitting an electronic document image via email to a recipient. It would have been obvious to one of ordinary skill in the art at the time of the invention to have enhanced Covington in view of Gormish and Russell so that the document image could have been transmitted to a recipient. A clear advantage of electronic documents over their paper counterparts is the ease with which an electronic document may be transmitted from one person to another electronically. It would have been obvious to one of ordinary skill in the art at the time of the invention to have transmitted the electronic document image to another person via email upon scanning the paper document into the system, thus utilizing the inherent advantage of electronic documents over paper documents..

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